

## REMARKS

This application contains claims 6, 8-11, 25-27, 36 and 37, all of which were rejected in the present Official Action. Claims 1-5, 7, 12-24, 28-35, 38 and 39 were withdrawn without prejudice in response to a restriction requirement. Reconsideration of the rejection of claims 6, 8-11, 25-27, 36 and 37 is respectfully requested.

Claims 6, 8-11, 25-27, 36 and 37 were rejected under 35 U.S.C. 102(e) over Hoefelmeyer et al. (U.S. Patent 6,618,389). Applicant respectfully traverses this rejection.

The present patent application was filed April 24, 2000. Hoefelmeyer was filed June 8, 2001, i.e., after the filing date of the present patent application, as a continuation-in-part of U.S. Patent Application 09/444,099, filed November 22, 1999 (now U.S. Patent 6,385,204). It is therefore clear that Hoefelmeyer is effective as prior art against the claims in the present patent application only to the extent that the parent application (U.S. Patent 6,385,204) discloses the subject matter of the claims. As noted in MPEP 706.02(f)(1)(B): "The 35 U.S.C. 102(e) date of a reference...is its earliest effective U.S. filing date, taking into consideration any proper benefit claims to prior U.S. applications under 35 U.S.C. 119(e) or 120 if the prior application(s) properly supports the subject matter used to make the rejection" (emphasis added). In other words, any disclosure made by Hoefelmeyer that does not also appear in U.S. Patent 6,385,204 is ineffective as prior art against the present patent application.

Claim 6 in the present patent application recites a method for testing of a communication network. A first traffic agent transmits a sequence of data packets via the network to a second traffic agent, wherein the sequence includes both communication test packets and packets associated with an application that is accessed via the network. The arrival characteristics of the packets are recorded, and a difference in the arrival characteristics of the communication test packets relative to those of the packets associated with the application is observed.

In rejecting this claim, the Examiner cited col. 2, line 40 *et seq.* in Hoefelmeyer, which describes validating a call processing network, including a mechanism for

measuring round-trip latencies of packets. The language of this passage, however, is entirely absent from Hoefelmeyer's parent application (U.S. Patent 6,385,204), which is concerned essentially with a network architecture and call processing system. A careful reading through all of U.S. Patent 6,385,204 reveals only a passing reference to any sort of testing, in a citation of later-filed U.S. Patent Application 09/877,890 (which became U.S. Patent 6,618,389) in col. 15, lines 46-67. (This reference must have been added to U.S. Patent 6,385,204 in an amendment during prosecution, after the filing date of U.S. Patent 6,618,389.) The parent application, U.S. Patent 6,385,204, itself neither teaches nor suggests measuring arrival characteristics of packets, let alone observing a difference in the arrival characteristics of communication test packets relative to packets associated with an application, as required by claim 6. Therefore, the effective date of Hoefelmeyer as a possible reference against claim 6 is not the parent filing date, but rather the actual filing date of U.S. Patent 6,618,389 itself - June 8, 2001.

Therefore, Applicant respectfully submits that Hoefelmeyer is ineffective as prior art against claim 6, and claim 6 is thus patentable over Hoefelmeyer.

Claim 8 recites a method for testing of a computer application accessed via a communication network, based on comparing exchange characteristics of application and test packets. This claim was rejected, according to the Examiner, on the same rationale as claim 6. Therefore, Applicant respectfully submits that Hoefelmeyer is ineffective as prior art against claim 8 for the same reasons as were stated above in regard to claim 6. Claim 8 is thus believed to be patentable over Hoefelmeyer, as are claims 9-11, which depend from claim 8.

Claims 25 and 36 recite, respectively, apparatus and a computer software product, which operate on principles similar to the method of claim 8. These claims were also rejected on the same rationale as claim 6. Applicant therefore believes these claims to be patentable over Hoefelmeyer for the reasons stated above. In view of the patentability of claims 25 and 36, claims 26, 27 and 30, which depend from claims 25 and 36, are believed to be patentable, as well.

Although the arguments above relate particularly to the Hoefelmeyer parent application (U.S. Patent 6,385,204), rather than to the Hoefelmeyer patent cited by


the Examiner (U.S. Patent 6,618,389), these arguments should not be construed in any way as an admission by Applicant that the subject matter of the claims in the present patent application is disclosed by U.S. Patent 6,618,389.

At the conclusion of the Official Action, the Examiner wrote that the prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant was unable to find any prior art made of record, however, other than Hoefelmeyer, and therefore has not related to any such prior art.

Applicant believes the remarks presented hereinabove to be fully responsive to all of the grounds of rejection raised by the Examiner. In view of these remarks, applicant respectfully submits that all of the claims in the present application are in order for allowance. Notice to this effect is hereby requested.

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Respectfully submitted,

  
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